

Application No. 10/613,689

REMARKS

Claims 1-16 are pending in the present application. Claims 1-16 have been rejected. In addition, Claim 10 was objected to.

By the present amendment, Claim 10 has been broadened in order to fully address and overcome the basis of the Examiner's objection under 35 USC § 112. It is believed that with this broadening amendment, Claim 10 distinctly points out and claims the subject matter which Applicant regards as the invention. Following this response, Claims 1-16 remain in this application.

Reconsideration and approval of the present application is respectfully requested in light of the foregoing amendment and in view of the following remarks.

Response to the Official Action

Rejection of Claims 1-16 under 35 USC § 102(b)

Paragraph 3. The Examiner has rejected Claims 1-16 of the application as allegedly anticipated by Greenwell et al., U.S. Patent No. 5,862,648. Applicant respectfully traverses the § 102 rejection for the reasons presented herein.

There is no dispute that for a § 102 rejection to stand the cited prior art referenced must disclose each and every limitation in a claim against which it is cited. See, e.g., Verdgaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."); MPEP § 2131.

One patentable distinction of the present invention is clearly understood with reference to upstream and downstream of the feed means. As taught by the present application, the feed means 220 receives packaging material such as an insert I from a direction of travel substantially perpendicular to the direction of travel of the articles to be fitted with the insert. More specifically, and as best illustrated in the present FIG. 3 reproduced immediately below, the feed means 220 receives packaging material from an

upstream plunger 200 and from an upstream direction X which are substantially perpendicular to the downstream direction of travel Y of the articles B.

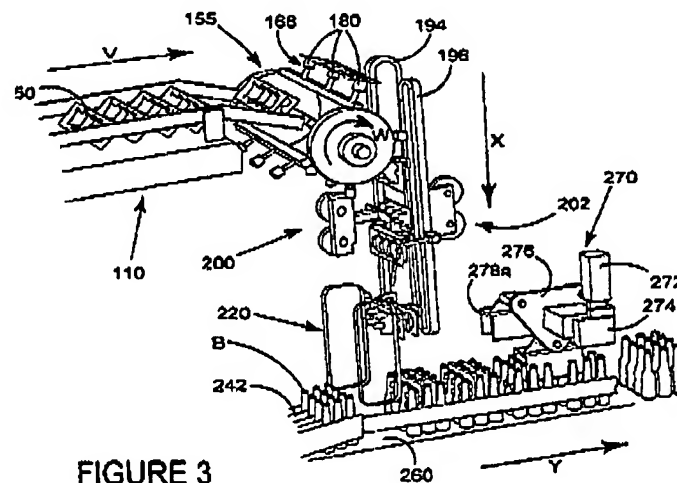


FIGURE 3

Accordingly, independent Claims 1 and 10 of the present application each include the element “feed means for feeding the packaging material *from* a direction substantially perpendicular *to* the direction of travel of the articles.” (*Emphasis Supplied*) As understood by the plain meaning of the claim language and taught by the specification, the limitation “*from* a direction substantially perpendicular” refers to the direction of travel of the packaging material upstream and is distinct of the feed means, while the limitation “*to* the direction of travel of the articles” refers to the direction of travel of the articles downstream and is distinct of the feed means.

In contrast to the claimed invention, Greenwell et al. neither teaches nor suggests the direction of the travel of the packaging material upstream of the feed means as being perpendicular to the downstream direction of travel of the articles. As taught by that reference and best illustrated in the related FIG. 1 reproduced immediately below, the direction of travel of the packaging material upstream of the feed means 11 is on a conveyor 12 that is substantially parallel to the downstream direction of travel of the articles MD. In fact, that the direction of travel upstream and downstream of the feed means are parallel is highlighted by the arrows labeled MD adjacent to both upstream conveyor 12 and

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downstream conveyor 23. As is plainly shown, both arrows are parallel and point in the same direction.

Further, if the conveyor 12 of Greenwell et al. was rotated to be perpendicular to the direction of travel downstream of the feed means 11, the unrestrained partitions P-1, P-2 would free-fall to the ground, entirely missing the feed means 11.

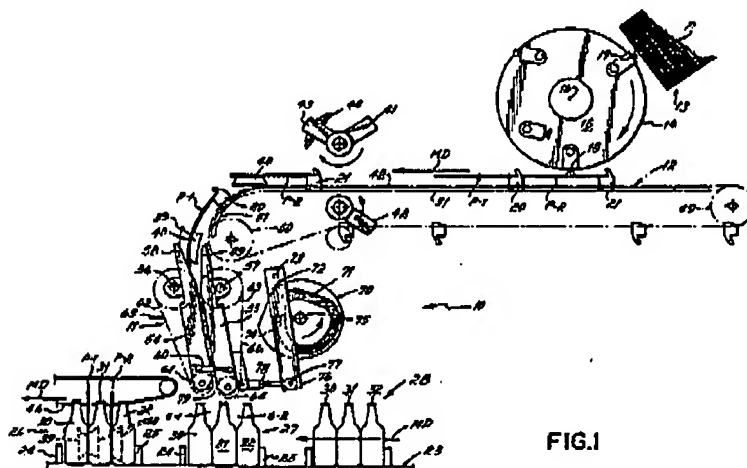


FIG. 1

Applicant submits that because Greenwell et al. neither teaches nor suggests each and every element as set forth in the present Claims 1 and 10, Greenwell et al. cannot anticipate the present invention.

In view of the foregoing, Applicant respectfully submits that independent Claims 1 and 10 are both patentable over the prior art of record. Accordingly, Applicant respectfully requests that the Examiner withdraw his rejections and allow independent Claim 1 together with dependent Claims 2-9, and allow independent Claim 10 together with dependent Claims 11-16.

*Application No. 10/613,689**Rejection of Claims 1-16 under 35 USC § 103(a)*

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2142.

For these reasons and others as discussed below, the Examiner has, respectfully, failed to factually support a *prima facie* case of nonobviousness. The Examiner's rejection will now be discussed in view of the prevailing law.

Claims 1-16 are not unpatentable over Greenwell et al.

Paragraph 3. Applicant respectfully traverses the obviousness rejection of Claims 1-16 in light of Greenwell et al. Greenwell et al. is directed to a different idea and a different solution, namely a traveling partition feeder 11 (feed means) that receives partition components P-1, P-2 from a horizontal upstream claim conveyor 12. More specifically, the feed means 11 includes fixed pivot ends 56, 57 for receiving partition components P-1, P-2 from the upstream and horizontal conveyor 12, and a discharge outlet 79 that articulates within a range. The structure taught and claimed in Greenwell et al. is markedly different from the structure taught and claimed in the present invention because the solution presented by Greenwell et al. is markedly different from the solution presented by the present invention.

With regard to the elements required to prove a *prima facie* case of obviousness, the Examiner's rejection fails to meet any of the three basic criteria. First, a careful review of the referenced art reveals there simply is no suggestion or motivation to modify Greenwell et al. to provide for a vertical conveyor 12. Even if such a suggestion or motivation was somehow

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manufactured, a person skilled in the art would understand a vertical conveyor 12 would not function with the feed means 11 for at least several reasons. The primary reason is that the conveyor 12 does not grip or otherwise secure the partitions at any point. Rather the conveyor 12 only pushes the partitions P-1, P-2 along a direction MD parallel to the direction of travel of the articles MD.

Indeed, to turn the conveyor 12 on end so that the direction of travel of the packaging material upstream of the feed means is perpendicular to the downstream direction of travel of the articles, would cause the partitions P-1, P-2 to flutter to the ground rather than be directed to the feed means because the conveyor 12 does not grip, secure, or otherwise provide for vertical transport or transfer of the partitions from a vertical conveyor to a feed means.

Further with regard to the basic criteria for establishing a *prima facie* case of obviousness, there would be no reasonable expectation of success even if the apparatus taught in Greenwell et al. was, in impermissible hindsight, reconfigured to resemble the present invention. As explained immediately above, because the conveyor 12 does not grip, secure, or otherwise provide for vertical transport or transfer of the partitions from a vertical conveyor to a feed means, there is no suggestion or motivation either expressly or inherently, to change the direction of packaging material upstream of the feed means.

In addition, with regard to the basic criteria for establishing a *prima facie* case of obviousness, Greenwell et al. does not teach or suggest the claim limitation of the direction of travel of the packaging material upstream the feed means being perpendicular to the direction of travel of the articles downstream of the feed means.

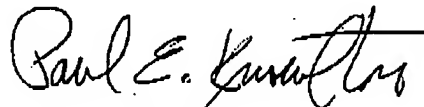
In view of the foregoing, Applicant respectfully submits that the claims presented herein are patentable over the references of record in this application. The preceding arguments are based only on the argument presented in the present Office Action, and therefore do not address patentable aspects of the inventions that were not addressed by the Examiner. The claims may include other elements that are not shown, taught, or suggested by the cited prior art. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other cases of patentability.

*Application No. 10/613,689***CONCLUSION**

After entry of the present amendment, Claims 1-16 will be pending in the present application. Applicant respectfully submits that entry of the amendment will place the present application in condition for allowance. Applicant also respectfully submits that, in light of the foregoing remarks, the rejections are improper and requests that they be withdrawn.

The foregoing is believed to be a full and complete response to the Office Action mailed September 30, 2004. Applicant thanks Examiner Kim for his consideration of the present amendment and remarks. With the foregoing, Applicant has shown the pending claims define patentable subject matter and a Notice of Allowance directed to the present applicant is respectfully requested.

Respectfully submitted,



Paul E. Knowlton
Reg. No. 44,842
Attorney for Applicant

Dated: December 30, 2004
PARKS KNOWLTON LLC
1117 Perimeter Center West
Suite W307
Atlanta, Georgia 30338
(678) 325-6603
(678) 325-6605 facsimile
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